

Notice of Allowability

Application No.

09/460,806

Examiner

Jonathan Ouellette

Applicant(s)

LEE, EUGENE M.

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 7/15/2005.
2. ☒ The allowed claim(s) is/are 1-3,5-7,11-14,25-29,31 and 32.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

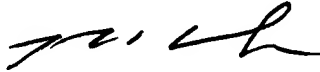
Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☒ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 20050805
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 20050909
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

DETAILED ACTION

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.
2. Authorization for this examiner's amendment was given in a telephone interview with the Attorney of record, Cynthia Nicholson, on 9/9/2005 (Reg.No 36,880).
3. The application has been amended as follows:
5. Claim 1, line 3, change "one" to "two"; beginning of line 4, before "determining", add "presenting a user with two or more target jurisdictions and one or more respective associates for each of at least a portion of said target jurisdictions, and the one or more fees associates with a particular one or ones of the intellectual property services further particularized by target jurisdiction and/or said one or more respective associates;"
6. Cancel Claim 4
7. Claim 11, line 3, change "one" to "two"; line 7, change "one" to "two"; line 12, change "one" to "two".
8. Claim 12, line 2, change "one" to "two".
9. Cancel Claims 15-24
10. Claim 29, line 2, change "one" to "two"; line 3, change "jurisdiction" to "jurisdictions".
11. Cancel Claim 30
12. Claim 31, line 3, change "one" to "two"; line 8, change "one" to "two".

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13. Claim 32, line 3, change "one" to "two"; line 14, change "one" to "two".

Response to Amendment

14. Claims 8-10 have been previously cancelled, and Claims 4, 15-24, and 30 have been cancelled by Examiner's Amendment. Claims 1-3, 5-7, 11-14, 31, and 32 are now pending in application 09/460,806.

Claim Rejections - 35 USC § 103

15. The rejection of Claims 1-7 and 11-32 under 35 U.S.C. 103(a) as being unpatentable over Brown, Pinnisi & Michaels, PC (www.lightlink.com/bbm, retrieved from Internet Archive Wayback Machine <www.archive.org>, date range: 2/24/1998-2/18/1999) in view of InventNet (www.inventnet.com, retrieved from Internet Archive WayBack Machine <www.archive.org>, date range: 12/3/1998-2/9/1999), is withdrawn due to Applicant's amendments and Examiner amendments.

Allowable Subject Matter

16. Claims 1-3, 5-7, 11-14, 25-29, 31, and 32 are allowed.
17. The following is an examiner's statement of reasons for allowance:
18. As per independent Claims 1, 11, 31, and 32, the prior art does not teach or suggest a computer implemented method, method, or computer program product for transacting an intellectual property service in connection with the filing of documents and/or payment of fees for intellectual property matters relative to two or more target jurisdictions, the method

comprising: presenting a user with two or more target jurisdictions and one or more respective associates for each of at least a portion of said target jurisdictions, and the one or more fees associates with a particular one or ones of the intellectual property services further particularized by target jurisdiction and/or said one or more respective associates; determining one or more intellectual property matters; providing, responsive to determination, a user with information representative of one or more intellectual property matters and one or more fees associated therewith wherein the fees include one or more of: official fees, and service fees; and selecting, responsive to the user, one or more of the intellectual property services for one or more of the intellectual property matters, and automatically initiating, by the computer, responsive to the user, performance of the selected one or more intellectual property services for one or more of the intellectual property matters.

19. BPM (Brown, Pinnisi & Michaels, PC (www.lightlink.com/bbm, retrieved from Internet Archive Wayback Machine <www.archive.org>, date range: 2/24/1998-2/18/1999) discloses a computer implemented method for transacting an intellectual property service in connection with the filing of documents and/or payment of fees for intellectual property matters, the method comprising: providing a user with information representative of one or more intellectual property matters (form of intellectual property protection); providing a user with information representative of one or more intellectual property services (search, filing, maintenance fees) corresponding to the one or more particular intellectual property matters and one or more fees associated therewith wherein the fees include one or more of: official fees, and service fees (pgs. 10-20).

20. BPM fails to expressly disclose transacting an intellectual property service in connection with the filing of documents and/or payment of fees for intellectual property matters relative to two or more target jurisdictions as disclosed in the independent claims.
21. BPM also fails to disclose presenting a user with two or more target jurisdictions and one or more respective associates for each of at least a portion of said target jurisdictions, and the one or more fees associates with a particular one or ones of the intellectual property services further particularized by target jurisdiction and/or said one or more respective associates; determining one or more intellectual property matters; providing, responsive to determination, a user with information representative of one or more intellectual property matters and one or more fees associated therewith wherein the fees include one or more of: official fees, and service fees; and selecting, responsive to the user, one or more of the intellectual property services for one or more of the intellectual property matters, and automatically initiating, by the computer, responsive to the user, performance of the selected one or more intellectual property services for one or more of the intellectual property matters, as described in the independent Claims.
22. InventNet discloses the registration and selection of one or more target jurisdictions/agents (pg. 7-9 and 11), but fails to teach presenting a user with one or more fees associates with a particular one or ones of the intellectual property services further particularized by target jurisdiction and/or said one or more respective associates; determining one or more intellectual property matters; providing, responsive to determination, a user with information representative of one or more intellectual property matters and one or more fees associated therewith wherein the fees include one or more of: official fees, and service fees; and

selecting, responsive to the user, one or more of the intellectual property services for one or more of the intellectual property matters, and automatically initiating, by the computer, responsive to the user, performance of the selected one or more intellectual property services for one or more of the intellectual property matters.

23. The remaining dependent Claims 2-3, 5-7, 12-14, and 25-29 are considered allowable, as they are dependent and based off of an allowable independent claim.
24. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

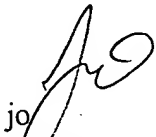
Conclusion

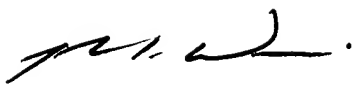
25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

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September 19, 2005


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